



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/634,309

08/04/2003

Nir Dotan

25681-501

7868

30623

7590

07/15/2008

MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C  
ATTN: PATENT INTAKE CUSTOMER NO. 30623  
ONE FINANCIAL CENTER  
BOSTON, MA 02111

EXAMINER

EWOLDT, GERALD R

ART UNIT

PAPER NUMBER

1644

MAIL DATE

DELIVERY MODE

07/15/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



Art Unit: 1644

### DETAILED ACTION

1. A request for continued examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed 5/01/08 in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's amendment and remarks filed 5/01/08 have been entered.
2. Claims 1, 2, 4, 6-10, 17, 18, and newly added Claims 60-69, are being acted upon.
3. In view of Applicant's amendments the previous rejections under the first and second paragraphs of 35 U.S.C. 112 have been withdrawn. Additionally, the obviousness-type double patenting rejection in view of U.S. Application No. 11/047,124 has also been withdrawn given that the claims in the '124 application are now drawn to a method employing a different set of antibodies.
4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).
5. Claims 1, 2, 4, 6-10, 17, 18, and newly added Claims 60-69 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over

Art Unit: 1644

Claims 28-32, 34, 35, 54-57, and 80-85 of U.S. Application No. 10/835,607. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the '607 application recite a related method employing the antibody species of the instant claims. NOTE: the rejection is now in view of the new claims filed 5/08/08. FURTHER NOTE: Applicant is required to respond to this rejection in response to this Office action. The rejection cannot be held in abeyance until the finding of allowable subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. The following are new grounds for rejection necessitated by Applicant's amendment.

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1, 2, 4, 6-10, 17, 18, and newly added Claims 60-69, are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter written description rejection.

The specification and the claims as originally filed do not provide support for the invention as now claimed, specifically:

A) the methods of Claims 1, and 60 comprising providing a test sample and detecting an anti-Glc( $\alpha$  1-4)Glc( $\alpha$ ) antibody.

B) the method of Claim 60 comprising diagnosing MS after a first neurological attack and prior to progression to relapsing-remitting episodes of worsening neurological function.

Art Unit: 1644

Applicant cites original claims and page 12 of the instant specification in support.

Regarding A), the specification at page 12 discloses only the use of blood and not the more generic test sample of the claims.

Regarding B) no support has been found for the specific limitation of detecting MS after a first neurological attack and prior to progression to relapsing-remitting episodes of worsening neurological function.

9. No claim is allowed.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Gerald Ewoldt whose telephone number is (571) 272-0843. The examiner can normally be reached Monday through Thursday from 7:30 am to 5:30 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eileen O'Hara, Ph.D. can be reached on (571) 272-0878.

11. **Please Note:** Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

/G.R. Ewoldt/  
G.R. Ewoldt, Ph.D.  
Primary Examiner  
Technology Center 1600